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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,978	11/16/2001	Yujiro Kajihara	501.32049RV1	7905

20457 7590 03/28/2003

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EXAMINER

CLARK, JASMINE JHIHAN B

ART UNIT	PAPER NUMBER
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2815

DATE MAILED: 03/28/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/987,978

Applicant(s)

KAJIHARA ET AL.

Examiner

Jasmine J B Clark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001 and 03 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s)     is/are withdrawn from consideration.
- 5) ☐ Claim(s)     is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s)     is/are objected to.
- 8) ☐ Claim(s)     are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on     is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on     is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No.    .  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s).
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.5. 6) ☐ Other:

### **DETAILED ACTION**

1. The preliminary amendment A filed 11/16/01 in paper No. 2 is informal (see page 1, for example), because the text to be added is not underlined. See 37 CFR 1.173(d), and MPEP 1453.

For the above reason, Applicants are notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

**Note also:** In page 2, applicants' indication in amendment A to cancel claims 37-49 is incorrect. There are no claims 37-49 to be canceled, but claims 1-14. And claims 1-14 have already been canceled by the Applicants.

### ***Claim Rejections - 35 USC § 112***

2. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is a method claim and it cannot depend on claim 15 which is a semiconductor device claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frechette et al. (US 4,868,635), Applicants' submitted prior art in view of Mitsubishi (JP 64-39740).

Frechette et al teach substantially all structures and features of the claimed invention, but fail to teach having a resin member for sealing the semiconductor chip, the chip mounting portion and the inner lead portions of the plurality leads, and wherein the one surface of the mounting chip portion is a surface on which burrs are formed, during formation of the chip mounting portion. Mitsubishi teaches employing a resin for sealing a semiconductor device, and preventing occurrence burrs. Hence, it would have been obvious for Frechette to have a resin member for sealing the semiconductor device, as is well known. Mitsubishi's teachings (see abstract) renders obvious the claimed invention which recites "wherein the one surface of the mounting chip portion is a surface on which burrs are not formed, during formation of the chip mounting portion, and wherein the burrs are formed when the lead frame is made by pressing".

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Concerning claims 17, 18, 24, and 25, Frechette fail to teach wherein the chip mounting portion has a substantially circular and/or cross form in a plane view. It would have been an obvious matter of design choice to have a substantially circular and/or cross form in a plane view of the mounting portion, since such modification would have involved a mere change in the size of a component. A change in form/shape is generally recognized as being within the level of ordinary skill in the art.

Concerning claim 20, Frechette fails to teach having parts of the inner lead portions of the leads be plated. Yoshioka teaches plating the parts of the inner leads. Hence, it would have been obvious for Frechette to plate parts of the inner leads, as is notoriously well known.

***Claim Rejections - 35 USC § 251, Recapture***

4. Claims 15-27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the

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broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitations, for example, "[s]uspension leads unitarily formed with the chip mounting portion,...said semiconductor chip is fixed to said mounting portion by adhesive..." were omitted from this new issue application. This omission provides a broadening aspect in the reissue claims, as compared to claims of the US Patent No. 5,637,913, and thus constitutes impermissible recapture of surrendered subject matter.

#### ***References Cited***

5. The references are cited and should be carefully considered: Taniura (JP 2-265721), Hajime (JP 56-64458), Miura (JP 58-123743), and Fujikawa (JP 2-94547) teach relating to a lead frame which includes burr.

#### ***Telephone Inquiry Contacts***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine J. B. Clark whose telephone number is (703) 308-4857.

The examiner can normally be reached on From M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lee can be reached on (703) 308-1690. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

jjbc/03/15/03



Jasmine J. B Clark  
Primary Examiner  
AU 2815